

5244-0084-2X



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

TETSURO MOTOMIYAMA

: EXAMINER: HO, C. T.

SERIAL NO: 09/192,583

: GROUP ART UNIT: 2153

FILED: NOVEMBER 17, 1998

FOR: METHOD AND SYSTEM FOR
COMMUNICATING WITH A DEVICE
ATTACHED TO A COMPUTER
USING ELECTRONIC MAIL MESSAGES

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REPLY BRIEF

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ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

MAR 15 2002

Technology Center 2100

SIR:

This Reply Brief is responsive to the Examiner's Answer mailed January 15, 2002.

The first fourteen pages of the Examiner's Answer repeat exactly what was stated by the Examiner in the last Office Action mailed July 5, 2001. This Reply Brief addresses the Examiner's "Response to Argument" set forth on pages 15-17 of the Examiner's Answer.

I. Claims 1 and 23 of Group I

At page 15 of the Examiner's Answer, the Examiner discusses the features of Kuwabara and McCormick. The Examiner's characterization of McCormick is a broad general characterization and does not address the specific teachings of McCormick et al which the Examiner has chosen to ignore. The correct characterization of McCormick et al is a method and system for filtering junk e-mails in the context of general purpose computers.

When one of ordinary skill in the art had before him a junk e-mail filtering system which would prohibit delivery of certain e-mails, it cannot be seen how such a teaching would provide motivation to modify Kuwabara to deliver an e-mail to a business office device (e.g., printer, facsimile machine, copier, postage machine, etc.) which is connected to a computer. The stretch is simply too far and is based on hindsight obtained from the teachings of the present invention. The Examiner cannot take the specific teachings of a reference such as McCormick which prohibits the delivery of junk e-mail, and say that such a filtering operation, when looked at from a generic point of view (e.g. routing of the e-mail) makes it obvious to route an e-mail to a business office device, as claimed. The modification attempted to be made by the Examiner is not consistent with the prior art.

Based on the improper use of hindsight, and the ignoring of the specific teachings and application in McCormick et al, the Examiner's arguments with respect to Claims 1 and 23 of Group I are incorrect and the invention of Group I should be allowed.

II. Claims 2 and 24 of Group II

As the Examiner merely states at the top of page 16 that Claims 2 and 24 are not patentable for the same reasons as Claims 1 and 23, the Applicant simply refers the Board to the arguments set forth immediately above with respect to Group I.

III. Claim 47 of Group III

Claim 47 of Group III relates to specific types of business office devices. The weakness of the Examiner's argument with regard to the rejection of Group III and specifically Claim 47 is clearly seen at the last sentence of page 16 which continues to the top of page 17 of the Examiner's Answer. In this sentence, the Examiner states that the type

of business device being used "would have been [a] design choice . . ." Based on the statements at column 1, lines 12 and 13 of Kuwabara, it is clear that the device reference in Kuwabara is some type of an industrial apparatus. Substituting a business office device such as a printer, scanner, etc. for an industrial device requires some type of motivation, and the Examiner's statement that such a substitution is simply a design choice is improper under the law of obviousness and Graham v. John Deere. Thus, it is clear that the rejection of Claim 47 must be withdrawn.

IV. The Invention of Group IV Including Claims 9, 18, 31, and 40

The invention of Group IV pertains to the use of a device driver. At the last page of the Examiner's Answer, the Examiner indicates that an interpreter is a device driver. However, the Examiner never clearly defines what definition of a device driver he is using. At the bottom of page 7 of the Appeal Brief, the proper interpretation of device driver is set forth as follows:

"A device driver is a known term of art and includes software that converts general input/output instructions of the operating system to messages that the device type can understand."

Included in the definition of a device driver is that the general input/output instructions are from the operating system. There is no use of input/output instructions of the operating system, as required by the invention of Group IV. An application program runs on top of the operating system, and the interpreter in Frantz which is referenced by the Examiner's Answer is an application program and not an operating system. Thus, what Frantz teaches clearly is not a device driver and Frantz does not meet the definition of a device driver.

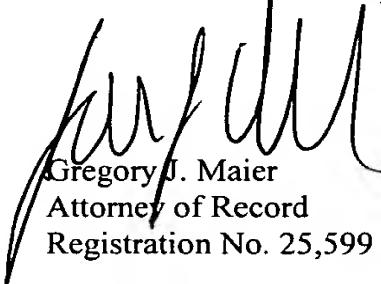
If the Examiner disagreed with the Applicant's definition of a device driver, then such a disagreement should be announced and the Examiner should set forth a clear and precise

definition of device driver which is being used. As the Examiner has not disagreed with the definition of a device driver set forth in the Appeal Brief, and the interpreter of Frantz does not meet the industry accepted definition of device driver, the rejection of Claims 18 and 40 must be withdrawn.

Based on the above, the rejection of each of the pending claims must be reversed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



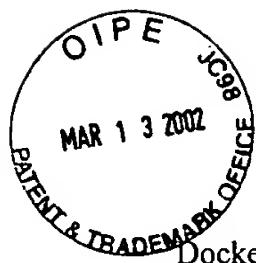
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Group Art Unit: 2153

Examiner: Chuong T. HO

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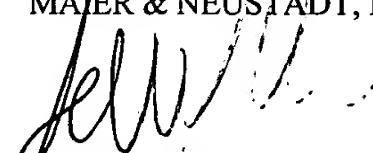
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**REPLY BRIEF (IN TRIPPLICATE)
REQUEST FOR ORAL HEARING**

Our check in the amount of **\$280.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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